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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,634	10/10/2000	Yoshihisa Usami	Q58611	1846

7590 10/04/2002

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EXAMINER
VARGOT, MATHIEU D

ART UNIT	PAPER NUMBER
1732	2

DATE MAILED: 10/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/684,634	Applicant(s) USA.41
	Examiner M. VIARBOT	Group Art Unit 1732

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Statu

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1–11 is/are pending in the application.

Of the above claim(s) 1 + 9 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 2–8, 10 + 11 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. § 119 (a)–(d)

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)–(d).

☒ All ☐ Some* ☐ None of the:

☒ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO–1449, Paper N (s). _____

☐ Interview Summary, PTO–413

☐ Notice of Reference(s) Cited, PTO–892

☐ Notice f Informal Patent Application, PTO–152

☐ Notice of Draftsperson's Patent Drawing Revi w, PTO–948

☐ Other _____

Office Action Summary

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1 and 9, drawn to an information recording medium, classified in class 428, subclass 64.1.

II. Claims 2-8, 10 and 11, drawn to a method of manufacturing an information recording medium, classified in class 264, subclass 1.33.

The inventions are distinct, each from the other because:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by drying the recording layer by methods other than using a clean air flow during rotation --for instance, the recording layer can be uniformly heated in an oven for a brief period of time.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Mexic on February 22, 2002 a provisional election was made with traverse to prosecute the invention of Group II, claims 2-8, 10 and 11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1

and 9 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

2. Claims 2-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2, last line, the term "narrow" is a relative term subject to various interpretations and hence renders the claims vague and indefinite. Applicant is requested to provide some qualification and/or clarification for this term.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art as set forth in the passages bridging pages 3 and 4 and pages 4 and 5 of the instant specification.

Applicant admits in the passage bridging pages 3 and 4 that it is known in the art to dry the recording layer by rotating the substrate at high speed and flow clean air toward the recording layer, further stating "when the intake... is wide..." (see page 3, last two lines). Given that the term "narrow" in claim 2 is subject to various interpretations, it is submitted that, at the very least, the instant claim is obvious over the admitted prior art. In the passage bridging pages 4 and 5,

applicant also admits that employing two dye application mechanisms for one molding machine is known in the prior art. This would indicate that the ratio n/m would be equal to 2. It is submitted that reducing this ratio to a number less than 2 would have been obvious dependent on molding cycle time and duty expected for the applicator machines. The exact number of such machines being employed per molding apparatus would have been within the skill level of the art dependent on cycle time required for the coating and simply would not constitute patentable subject matter. Hence, instant claims 10 and 11 are obvious over the prior art.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Slater et al discloses a cooling carousel for optical disks and Hayashi et al a cooling device for injection molded articles. Satoh (see Example 12 and Fig. 4B) shows the instant laminated disk. Kanome also teaches laminated disks. Motokawa et al teaches injection molding to make a substrate for an optical disk and bonding the substrates together.

5. Applicant is requested to provide references which disclose the closest prior art concerning the clean air drying.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Vargot whose telephone number is 703 308-2621.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.

M. Vargot

September 29, 2002

MATHIEU D. VARGOT
PRIMARY EXAMINER
GROUP 1300